

Appl. No. 10/034,220
Amdt. dated December 12, 2005
Reply to Office action of October 18, 2005

REMARKS

Applicants have received the Office action dated October 18, 2005, in which the Examiner: 1) rejected claims 9-17 and 21-26 as allegedly indefinite; 2) rejected claims 1-2 and 5-8 as anticipated by allegedly admitted prior art (AAPA); 3) rejected claims 31 and 33 as allegedly anticipated by Chou (U.S. Pat. No. 5,892,906); 4) rejected claims 3-4 and 18-20 as allegedly obvious over AAPA and Hopmann (U.S. Pat. No. 6,578,069); 5) rejected claims 32 and 34 as allegedly obvious over Chou and Hopmann; and 6) indicated claims 9 and 21 would be allowable if rewritten to overcome the indefiniteness rejection.

With this Response, Applicants amend claims 1-5, 9 and 21.

I. EFFECTIVELY ALLOWED CLAIMS

The Office action dated October 18, 2005 rejects claims 9-17 and 21-26 as allegedly indefinite, but otherwise allowable. Applicants amend claim 9 and 21 to make more clear that the unique identification numbers are generated from random numbers (claim 21) or from one or more of random numbers or the network address of the computer generating the GUID (claim 9). Applicants respectfully submit that claims 9-17 and 21-26 should now be in a condition for allowance.

II. ART-BASED REJECTIONS

A. Claim 1

Claim 1 stands rejected as anticipated by allegedly admitted prior art. Applicants amend claim 1 to remove much of the preamble terminology, and to more clearly define over the interpretation of the Office action of a BIOS with a single routine.

Claim 1 specifically recites, "identifying with a unique identification number a first basic input/output system (BIOS) routine of a plurality of BIOS routines..." A BIOS version and date does not "identify[] with a unique identification number a first [] BIOS [] routine of a plurality of BIOS routines." For this reason alone claim 1 should be allowed.

Moreover, claim 1 recites, "correlating the unique identification number to at least a services number in a data table; and determining, by a BIOS calling

Appl. No. 10/034,220
Amdt. dated December 12, 2005
Reply to Office action of October 18, 2005

program, a services number of the first BIOS routine based on the unique identification number from the data table." In the response to arguments section, the Office action indicates that a services number is used as the index into the table.

The examiner interprets the **services number to be equivalent to an index in a database**, which index is associated with a record (the record being the BIOS routine's unique identification number comprising a version number and date). ... **Determining ... the services number will provide the operating system with an index which will be used to search** for the associated record in the BIOS information table.

(Office action of October 18, 2005, paragraph spanning pages 3 and 4 (emphasis added)). The shortcoming of this argument is two-fold. Firstly, the claim recites, **"determining ... a services number of the first BIOS routine based on the unique identification number from the data table."** This recitation is precisely opposite of the reasoning of the Office action where the services number is used as the index into the table. Secondly, the rejection is an anticipation rejection, yet Applicants can find no express or inherent teaching in their Background section that the BIOS information table there recited could be used to "determin[e] ... a services number ... based on the unique identification number from the data table."

Based on the foregoing, Applicants respectfully submit that claim 1 is not anticipated by their Background section, and should be allowed together with all claims that depend from claim 1 (claims 2-4). Applicants amend claims 2-4 to reflect the amendments to claim 1

B. Claim 5

Claim 5 stands rejected as anticipated by allegedly admitted prior art. Applicants amend claim 5 to more clearly define over the interpretation of the Office action of a BIOS with a single routine.

Claim 5 specifically recites "a basic input/output system (BIOS) read only memory (ROM) coupled to the CPU, the BIOS ROM comprising a plurality of BIOS routines; and a data table stored within the BIOS ROM, and wherein the

Appl. No. 10/034,220
Amdt. dated December 12, 2005
Reply to Office action of October 18, 2005

data table correlates a unique identification number for a single BIOS routine to a BIOS call services number for the single BIOS routine." A BIOS version and date, even if extracted from the BIOS information table discussed in the Background section, does not "correlate[] a unique identification number for a single BIOS routine to a BIOS call services number for the single BIOS routine."

Based on the foregoing, Applicants respectfully submit that claim 5 is not anticipated by their Background section, and should be allowed together with all claims that depend from claim 5 (claims 6-8).

C. Claim 18

Claim 18 stands rejected as obvious over allegedly admitted prior art and Hopmann.

Applicants respectfully submit that the Office action fails to make a *prima facie* case of obviousness. The Manual of Patent Examining Procedures (MPEP) clearly states:

The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination.**

(MPEP 8th Ed., Rev. 2, Section 2143.01, page 2100-131 (underlining original, bold emphasis added)). Certainly Applicants Background section does not make such a suggestion, and neither does Hopmann. Hopmann is directed to a method, data structure, and computer program product for identifying a network resource. (Hopmann Title). The "resources" to which Hopmann refers are resources that are readily changeable and modifiable by the user, such as Web pages, documents and e-mail (Hopmann Col. 1, lines 34-39) accessed over a network to which the user may selectively connect and disconnect. (Hopmann Col. 2, lines 10-15). Hopmann discloses "resource tags" to identify resources, but these resource tags are also readily modifiable to identify particular versions of the resource, such as when the resource is modified by the user. (Hopmann Col. 8, lines 1-4). Thus, there are two important aspects to consider, the resource tags of Hopmann change, and so do the resources. Claim 18, by contrast, is directed to a BIOS **read only memory** having various features. Applicants

Appl. No. 10/034,220
Amdt. dated December 12, 2005
Reply to Office action of October 18, 2005

respectfully submit that Hopmann does not suggest a combination or modification to a system where Hopmann's resources and resource tags are not readily modifiable by the user, such as would be the case if Hopmann's resources and resource tags were stored on a read only memory along with the BIOS. For this reason alone the Office action fails to make a *prima facie* case of obviousness. The MPEP further states:

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggesting or motivation to make the proposed modification.

(*Id.*) Clearly, if the Hopmann system had to flash an EPROM device, a time consuming process, each time one of Hopmann's resource tags changed, then Hopmann would be rendered unsatisfactory for its intended purpose. For this additional reason, the Office action fails to make a *prima facie* case of obviousness.

Moreover, even if Applicants' Background and Hopmann are hypothetically considered together (which Applicants do not admit is proper), the Background and Hopmann still fail to teach the limitations of claim 18. In particular, the Background and Hopmann fail to teach or suggest "a correlation table **stored on the BIOS ROM, the correlation table correlates a Globally Unique Identifier (GUID) to a service number for at least one BIOS routine.**"

Based on the foregoing, Applicants respectfully submit that claim 18 should be allowed together with all claims that depend from claim 18 (claims 19-20).

D. Claim 31

Claim 31 stands rejected as allegedly anticipated by Chou, and is listed under a Section 112, sixth paragraph, heading, but the Office action does not expressly lodge a Section 112 rejection.

Claim 31 is written in a means-plus-function format, and as to this Office action states:

However, the examiner respectfully notes that the corresponding structure, material, or acts in support of the functions recited in the claim 31 are not readily found described in the specification...

Appl. No. 10/034,220
Amdt. dated December 12, 2005
Reply to Office action of October 18, 2005

(Office action of October 18, 2005, page 6, second full paragraph). Applicants respectfully traverse this assertion, and direct the Examiner's attention to CPU 10 (as an example of a means for executing software programs), the main memory 26 (as an example of a means for storing data and programs), and to the BIOS ROM 42 (as an example of both the means for storing BIOS routines and the means for storing unique identification numbers).

Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

(MPEP 8th Ed., Rev. 2, Section 2101, page 2100-220).

Chou is directed to an apparatus and method for preventing theft of computer devices, (Chou Title), which immediately calls into question its applicability to the current claims. The location in Chou cited by the Office action is a discussion directed to Figure 3, which describes the organization of a ROM containing BIOS routines and routines for implementation of the security system of Chou. (Chou Col. 3, line 52 through Col. 4, line 27). Apparently in Chou, before a POST routine (termed BIOS routines in some instances by Chou) is fully executed, contents of a memory location are checked. (Chou Col. 4, lines 42-45). If the memory location indicates a locked condition, the POST routines stops execution. (Chou Col. 4, lines 45-47).

Claim 31, by contrast, specifically recites, "a means for storing unique identification numbers of BIOS routines correlated to BIOS call service numbers for the BIOS routines, the means for storing unique identification numbers associated with the means for storing BIOS routines." Applicants respectfully submit that Chou fails to teach, suggest or even imply such a structure. Chou's Figure 3 certainly does not show **"a means for storing unique identification numbers of BIOS routines correlated to BIOS call service numbers for the BIOS routines ..."**

Based on the foregoing, Applicants respectfully submit that claim 31 is not taught or rendered obvious by Chou, and thus claim 31 should be allowed together with claims that depend from claim 31 (claims 32-34).

Appl. No. 10/034,220
Amdt. dated December 12, 2005
Reply to Office action of October 18, 2005

III. CONCLUSION

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



Mark E. Scott
PTO Reg. No. 43,100
CONLEY ROSE, P.C.
(512) 320-9182 (Phone)
(512) 391-1900 (Fax)
ATTORNEY FOR APPLICANTS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Dept., M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400